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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/912,818 | 07/24/2001 | Daniel Pinkel | 407E-914026US | 8113 |

22798 7590 05/05/2003

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EXAMINER

FREDMAN, JEFFREY NORMAN

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1634

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/912,818

Applicant(s)

PINKEL ET AL.

Examiner

Jeffrey Fredman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 45-67.

Claim(s) objected to: _____.

Claim(s) rejected: 68-71, 74-76.

Claim(s) withdrawn from consideration: 72, 73, 77-86.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Jeffrey Fredman
Primary Examiner
Art Unit: 1634

Continuation of 2. NOTE: The cancellation of the claims would require further search and consideration of nonelected species. As MPEP 803.02 makes clear regarding after final practice regarding Markush claims "Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry"..

Continuation of 3. Applicant's reply has overcome the following rejection(s): The terminal disclaimer was effective to overcome the double patenting rejection. Consequently, claims 45-67, which are drawn to methods which detect specific alterations using comparative genomic hybridization, are free of the prior art and are allowable over the prior art, since the base teaching of comparative genomic hybridization itself is required by the claims.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that the 103 rejection is incorrect because a translocation is not the same as an amplification. While this may be correct, the claim does not state only "amplification" but "amplification or gain". The translocation is clearly a "gain" at that location. Thus, there is an express teaching by Hainsworth of a "gain" which falls within the scope of the claims. Applicant's entire argument is address towards the word "amplification". However, this claim is not limited to "amplification" but expressly includes the word "gain", which is expressly taught by Hainsworth. Therefore, the prior art rejection is proper and is maintained..